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REMARKS

Claims 1-47 are currently pending in the subject application and are presently under consideration. Claims 1 and 38 have been amended as shown on pp. 2-9 of the Reply.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

**I. Rejection of Claims 38 and 39 Under 35 U.S.C. §101**

Claims 38 and 39 stand rejected under 35 U.S.C. §101 for lacking utility. This rejection should be withdrawn for at least the following reasons. Claims 38 and 39 produce a useful, concrete and tangible result, and further, the subject claim pertains to the transmission of software code between two or more computer processes.

Because the claimed process applies the Boolean principle [abstract idea] ***to produce a useful, concrete, tangible result*** ... on its face the claimed process comfortably falls within the scope of §101. *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358. (Fed. Cir. 1999) (Emphasis added); *See State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed.Cir.1998). The inquiry into patentability requires an examination of the contested claims to see if the claimed subject matter, as a whole, is a disembodied mathematical concept representing nothing more than a "law of nature" or an "abstract idea," or if the mathematical concept has been ***reduced to some practical application rendering it "useful."*** *AT&T* at 1357 citing *In re Alappat*, 33 F.3d 1526, 31 1544, 31 U.S.P.Q.2D (BNA) 1545, 1557 (Fed. Cir. 1994) (emphasis added).

The Examiner contends that the steps of claims 38 and 39 *consist solely of a data field or a data packet to be transmitted and analyzing steps that do not produce a tangible result*. Applicants' representative disagrees and submits that the Examiner is misconstruing the requirements necessary to fulfill the conditions for patentability under 35 U.S.C. §101. According to *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352 (Fed. Cir. 1999), the standard set forth by the Federal Circuit for determining whether claims are directed towards statutory subject matter is whether the claims as a whole can be applied in a practical application to ***produce a useful, concrete and***

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***tangible result.*** It is the result of the claims as applied in a practical application that is germane to the determination of whether the claims are directed towards statutory subject matter, not whether the underlying means by which the result is effectuated that should be tangible, as the Examiner intimates. It is believed therefore that the subject claim clearly satisfies this legal standard. In particular, independent claim 38 recites: ***a data packet adapted to be transmitted between at least two computer processes, comprising a data field comprising information for regulating operation of a business component based at least upon prognostic data concerning a machine.*** Claim 39, in addition to reciting the analyzing acts noted by the Examiner, also recites ***specifying machine acquisition based at least in part upon the analyses.*** Thus, claims 38 and 39 elicit a series of independent acts that culminates in a useful, concrete and tangible result.

Additionally, the Court of Appeals for the Federal Circuit stated in *Eolas Techs., Inc. v. Microsoft Corp.*, 399 F.3d 1325 (Fed. Cir. 2005):

Title 35, section 101, explains that an invention includes "any new and useful process, machine, manufacture or composition of matter." ... Without question, ***software code alone qualifies as an invention eligible for patenting under these categories***, at least as processes. *Id.* at 1338 (emphasis added).

The subject claim clearly pertains to software code comprising a data field having regulating instructions, encapsulated in a data packet transmitted from one computer process to another computer process, so that the regulating instructions therein can be employed to regulate the operation of a business component based at least upon prognostic data concerning a machine. The fact that (i) the data packet that encases the software code during its transmission between two processes, or (ii) the data packet is transmitted as a communication signal between two processes is irrelevant to the fact that it is software code that is contained therein and is being transmitted through utilization of a communication signal. It is submitted that all that is relevant is the fact that software code is being transmitted within the data packet, and that the software code so transmitted produces a useful, concrete and tangible result. In view of at least the aforementioned reasons, the rejection of claims 38 and 39 should be withdrawn.

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## II. Rejection of Claims 1-47 Under 35 U.S.C. §102(e)

Claims 1-47 stand rejected under 35 U.S.C. §102(e) as being anticipated by Gotou *et al.* (US 2002/0013635 A1). This rejection should be withdrawn for at least the following reasons. Gotou *et al.* does not disclose or suggest every limitation set forth in the subject claims.

A single prior art reference anticipates a patent claim only if it *expressly or inherently describes each and every limitation set forth in the patent claim*. Trintec Industries, Inc. v. Top-U.S.A. Corp., 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002); See Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The *identical invention must be shown in as complete detail as is contained in the ... claim*. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

Applicant's claimed subject matter relates to a *system that facilitates optimizing industrial business operations, including a prognostics engine that infers at least one future state of the operations based in part on the received data and includes: a plurality of intelligent software agents that serve as proxies for at least the subset of machines, for modeling and representing interactions with one another, and for facilitating convergence on modification and control of the subset of machines, for efficiently optimizing industrial business operations*. Independent claims 1, 10, 33, 44 and 47 recite similar limitations. Gotou *et al.* does not disclose or suggest these novel features of applicant's claimed subject matter.

Gotou *et al.* relates to a system for monitoring the status of abnormality and lifetime of machine components such as a bearing having rolling elements. With respect to claim 1, the Examiner again asserts that Gotou *et al.* discloses a system having a component for receiving machine data and a prognostics engine for inferring future states of machines from this data, citing paragraphs [0011], [0012], [0013], [0051] and [0052]. However, these cited passages simply disclose a system capable of remotely monitoring and determining status of machine components sold to a client corporation, for estimating

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the lifetime of these components. A machine component monitoring and diagnosing system is disclosed therein that includes "a sensor for detecting a factor associated with lifetime of a machine component." The sensor data is transmitted to a remote business establishment, where it is received by "a diagnosing means for diagnosing the status of the lifetime of the machine component." In this way, the business establishment can remotely diagnose and monitor the status of machine components at a client corporation. However, it remains clear that the cited passages of Gotou *et al.* simply fail to disclose or suggest a *prognostics engine* that includes a *plurality of intelligent software agents for modeling and representing interactions between the subset of machines, for efficiently optimizing industrial business operations*, as recited in the present independent claims. Therefore, Gotou *et al.* fails to disclose *every aspect of the claimed invention* as is required in order to show anticipation. Thus, it is readily apparent that the claims and the cited document are distinguishable on at least this ground. Accordingly, the rejection should be withdrawn with respect to independent claims 1, 10, 33, 36, 37, 44 and 47 (and claims that depend there from).

Claim 38 recites *a data packet adapted to be transmitted between at least two computer processes, comprising a data field comprising information for regulating operation of a business component based at least upon prognostic data concerning a machine*. In rejecting of claim 38, the Examiner simply cites Fig. 24 of Gotou *et al.* However, it is again maintained that no such data packet having the claimed aspects can be found from Fig. 24. And in response to the previous Reply, the Examiner has failed to either specifically point out the claimed features or else withdraw the rejection. In any event, it has readily apparent that Fig. 24 fails to shows *every aspect of the claimed invention*, and the Examiner has therefore failed to make a satisfactory showing of anticipation in accordance with 35 U.S.C. § 102(e). For at least these reasons, the rejection of claim 38 should be withdrawn.

Claim 39 recites *an industrial automation layout methodology* including a number of specific acts. In rejecting this claim, the Examiner again cites Fig. 24 of Gotou *et al.* In regards to the claimed act of *analyzing machine related prognostic data*, the Examiner again cites "business establishment (101) of the manufacturing and selling corporation." In connection with the claimed *analyzing business concern data* and *analyzing business*

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*objective data*, the Examiner respectively cites "PROPER REPLACEMENT BUDGET" and "PROPER STOCK MANAGEMENT." However, these elements are shown in Fig. 24 in a bullet list next to "business establishment (102) of the client corporation." And with respect to the claimed *specifying machine acquisition based at least in part upon the analyses*, the Examiner cites paragraphs [0057] and [0075] of Gotou *et al.* However, these paragraphs are directed to methods of inventory control and budget planning. Thus, it is readily apparent that the cited passages do not meet the claimed aspects. In view of at least the foregoing reasons, the rejection of claim 39 should be withdrawn.

Claim 40 recites a *computer-implemented method for ordering parts in an industrial automation environment*. In regards to the claimed act of *automatically receiving an analyzing data relating to a prognosis of a future state of a machine*, the Examiner again relies on "business establishment (101) of the manufacturing and selling corporation." In connection with the claimed *automatically inferring a failure period for at least one part of the machine and automatically ordering a replacement for the at least one part prior to the inferred failure period*, the Examiner again cites paragraph [0057] of Gotou *et al.* However, it is evident from this cited passage that Gotou *et al.* is simply concerned with maintaining an inventory of parts on hand so as to foresee upcoming demands for replacement parts. Clearly, Gotou *et al.* is not performing *inferring a part failure and automatically ordering a replacement prior to an inferred failure period* as claimed. Thus, the cited document and the claimed subject matter are distinguishable on this ground, and the rejection of claim 40 (and claims that depend therefrom) should be withdrawn.

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CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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